

Customer No.: 31561
Application No.: 10/709,720
Docket No.: 11249-US-PA

REMARKS

Present Status of the Application

Claims 1-5 remain pending. The Advisory Action dated August 14, 2006 has continued to reject claims 1-5 under 35 U.S.C. 103(a) as being unpatentable over Deluca et al. (US-5,784,001, hereinafter Deluca) in view of Miyashita (US-005574439A, hereinafter "Miyashita").

The Reply dated June 02, 2006 has failed to place the application in condition for allowance for the reasons described below:

The advisory action has alleged that the claimed invention only requires the inserting content to include a text message, and that the claimed invention is not limited to a text message. And as recited in the Final Rejection, Miyashita discloses a system which include the use of text (col. 3, lines 26-40) – in Page 2 of the Advisory Action.

For at least the following reasons, Applicant respectfully submits that claims 1-5 are in proper condition for allowance. Reconsideration is respectfully requested.

Discussion of the claim rejections under 35 USC 103

Claim 1

Regarding claim 1, as was discussed in great details in the previous response to OA, the use of graphic messages on the display 130 in Deluca is emphasized to be critically important for the essence of the invention taught in Deluca, because only graphic messages

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allow for “providing selective call messages that are not language-specific”, which is not possible when using a TEXT-based system as is the case in the present invention.

Therefore, Deluca clearly teaches having BOTH of the following: 1) the inserting content is to comprise of graphic message (which is not language dependent); and 2) Not having text messages (since text messages are clearly language dependent).

Please note that the feature in 2) above is taught inherently and not explicitly; nevertheless, it would have been obvious for one skilled in the art in coming up with the teachings of “2) Not having text messages” based on the overall disclosure of Deluca which are to be “*not language-specific*”.

On the other hand, the amended claim 1 of the present invention clearly recites the patentable feature “acquiring an inserting content consisting of a text message”. Thus, because claim 1 teaches of an inserting content which consist of TEXT messages, and Deluca teaches of NOT having text messages (as taught inherently in Deluca and described above), it then follows that Deluca is clearly teaching away from the claimed invention, and therefore cannot be used in a rejection under obviousness per 35 U.S.C. 103(a). The patentable feature “acquiring an inserting content consisting of a text message” is fully supported in Paragraphs [0018] and [0020] where examples of the content of the short messages clearly show that the inserting content consist of text messages.

In other words, if claim 1 includes a feature called “A” and Deluca teaches inherently of “Not possible to have A”; then it follows that by having “A”, claim 1 is then clearly patentable over Deluca, wherein inherently does not have A.

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Without Deluca, Miyashita alone is clearly insufficient for forming a prima facie of case of obviousness.

Without Deluca being considered acceptable as a valid reference under 35 USC 103(a) rejection, it is moot whether Miyashita alone would disclose a system that includes the use of text.

Claims 2-5, which directly depend from the independent claim 1 are also patentable over Deluca at least because of their dependency from an allowable base claim.

For at least the foregoing reasons, Applicants respectfully submit that claims 1-5 patently define over the cited references. Reconsideration and withdrawal of above rejections is respectfully requested.

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CONCLUSION

For at least the foregoing reasons, it is believed that all pending claims 1-5 are in proper condition for allowance. If the Examiner believes that a conference would be of value in expediting the prosecution of this application, he is cordially invited to telephone the undersigned counsel to arrange for such a conference.

Date :

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Respectfully submitted,

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